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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,018

08/03/2007

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40006572-0001-002

4096

26263

7590

09/15/2009

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EXAMINER

POLLACK, MELVIN H

ART UNIT

PAPER NUMBER

2445

MAIL DATE

DELIVERY MODE

09/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,018	<b>Applicant(s)</b> BHUMKAR ET AL.	
	<b>Examiner</b> MELVIN H. POLLACK	<b>Art Unit</b> 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/9/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-9, 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The term "delivery data includes" in claims 6, 15 is a relative term which renders the claim indefinite. The term "includes" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The lack of any words such as "and", "or" or "at least one of" exacerbates the problem of determining whether the list is closed or open, and whether the list may comprise any element or must contain the entire set. For the purposes of this action, the examiner interprets claim 6 such that the delivery data comprises at least one of the listed elements, but may include other unlisted elements besides.
5. Claims 7-9, 16-18 inherits the above claim problem, and do not correct such problem.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-8, 10, 12-17, 19-21, 23-28, 30-33, 35, 37-41, 43-46 are rejected under 35

U.S.C. 103(a) as being unpatentable over Malone et al. (7,426,533) in view of Alexander et al.

(6,988,128).

3. For claim 1, Malone teaches a method (abstract; col. 1, line 1 – col. 3, line 40; col. 11, lines 20 – 25), comprising:

- a. providing for one or more contacts (col. 3, lines 55 – 60) to be included in an e-mail message addressed to a unique e-mail address (col. 4, lines 35 – 50);
- b. receiving the e-mail message at a server associated with the unique e-mail address (col. 3, line 60 – col. 4, line 25);
- c. extracting the one or more contacts from the e-mail message (col. 6, lines 10 – 25);
- d. determining a wireless device to send the one or more contacts to (col. 5, lines 45 – 55);
- e. generating one or more messages (col. 10, lines 15 – 40) formatted specifically for the wireless device (col. 6, lines 25 – 50), wherein the one or more messages contain the one or more contacts (col. 7, lines 60 – 65);
- f. checking if the wireless device is registered with the server (col. 5, lines 10 – 50);  
and
- g. sending the one or more messages to the wireless device (col. 8, lines 5 – 25) if the wireless device is registered with the server (col. 3, lines 40 – 55).

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4. Malone does not expressly disclose extracting delivery data contained in the e-mail message. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25) over wireless networks (col. 5, line 25 – col. 6, line 40). Alexander further teaches extracting delivery data (col. 7, line 30 – col. 8, line 25; col. 9, lines 5 – 45) in order to determine which wireless device to send the contacts to (col. 11, line 60 – col. 14, line 35). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).
5. For claims 3, 12, Malone teaches sending an invitation message to the wireless device to register with the server (col. 9, line 30 – col. 10, line 15).
6. For claims 4, 13, Malone teaches adding the contacts received in the e-mail to a contact list stored on the server (col. 8, lines 45 – 60).
7. For claims 5, 14, Malone teaches that the wireless device is an SMS-enabled wireless device (col. 11, lines 1 – 5).
8. For claims 6, 15, Malone teaches that the delivery data includes a phone number, a recipient's e-mail address, a user ID, or a sender's e-mail address (col. 5, lines 10 – 30).
9. For claims 7, 16, Malone teaches that the delivery data is extracted from a subject section of the e-mail message (col. 6, line 30 – col. 7, line 45).
10. For claims 8, 17, Malone teaches that the delivery data is extracted from the body section of the e-mail message (col. 6, line 30 – col. 7, line 45).
11. For claim 10, Malone teaches a method (abstract; col. 1, line 1 – col. 3, line 40; col. 11, lines 20 – 25), comprising:

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- a. providing for one or more events (col. 3, lines 55 – 60) to be included in an e-mail message addressed to a unique e-mail address (col. 4, lines 35 – 50);
  - b. receiving the e-mail message at a server associated with the unique e-mail address (col. 3, line 60 – col. 4, line 25);
  - c. extracting the one or more calendar events from the e-mail message (col. 6, lines 10 – 25);
  - d. determining a wireless device to send the one or more calendar events to (col. 5, lines 45 – 55);
  - e. generating one or more messages (col. 10, lines 15 – 40) formatted specifically for the wireless device (col. 6, lines 25 – 50), wherein the one or more messages contain the one or more calendar events (col. 7, lines 60 – 65);
  - f. checking if the wireless device is registered with the server (col. 5, lines 10 – 50);  
and
  - g. sending the one or more messages to the wireless device (col. 8, lines 5 – 25) if the wireless device is registered with the server (col. 3, lines 40 – 55).
12. Malone does not expressly disclose extracting delivery data contained in the e-mail message, nor that the events are calendar events. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25) over wireless networks (col. 5, line 25 – col. 6, line 40). Alexander further teaches extracting delivery data (col. 7, line 30 – col. 8, line 25; col. 9, lines 5 – 45) in order to determine which wireless device to send the contacts to (col. 11, line 60 – col. 14, line 35). At the time the invention was made, one of ordinary skill in the art would

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have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).

13. For claim 19, Malone teaches a method (abstract; col. 1, line 1 – col. 3, line 40; col. 11, lines 20 – 25), comprising:

- a. providing for a text message (col. 11, lines 1 – 5) to be entered (col. 3, lines 55 – 60) into a wireless device (col. 6, lines 25 – 50) and sent to a unique phone number (col. 4, lines 35 – 50);
- b. receiving the text message at a server (col. 3, line 60 – col. 4, line 25); and

14. Malone does not expressly disclose storing the text message in a user account on the web server associated with the wireless device. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25) over wireless networks (col. 5, line 25 – col. 6, line 40). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).

15. For claim 20, Malone teaches a method further comprising:

- a. determining an e-mail address to send the text message to (col. 5, lines 45 – 55);  
and
- b. sending the text message to the e-mail address (col. 8, lines 5 – 25) if the wireless device is registered with the server (col. 3, lines 40 – 55).

16. Malone does not expressly disclose extracting delivery data contained in the e-mail message. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25)

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over wireless networks (col. 5, line 25 – col. 6, line 40). Alexander further teaches extracting delivery data (col. 7, line 30 – col. 8, line 25; col. 9, lines 5 – 45) in order to determine which wireless device to send the contacts to (col. 11, line 60 – col. 14, line 35). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).

17. For claim 21, Malone teaches that the delivery data includes a phone number of the wireless device and the e-mail address (col. 5, lines 10 – 30).

18. For claim 23, Malone teaches sending an invitation to the e-mail address, if the e-mail address is not registered with the server (col. 9, line 30 – col. 10, line 15).

19. For claim 24, Malone teaches a method (abstract; col. 1, line 1 - col. 3, line 40; col. 11, lines 20 - 25), comprising:

- a. providing for one or more contacts (col. 3, lines 55 – 60) to be selected via a web browser from a first contact list (col. 6, lines 10 – 35); and
- b. sending the one or more contacts (col. 8, lines 5 – 25) to an SMS-enabled wireless device (col. 11, lines 1 – 5) if the wireless device is registered with the web server (col. 3, lines 40 – 55; col. 5, lines 10 - 50).

20. Malone does not expressly disclose lists stored on a web server. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25) over wireless networks (col. 5, line 25 – col. 6, line 40). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).



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21. For claims 25, 39, Malone teaches checking if the wireless device is registered on the web server (col. 5, lines 10 – 50) and associated with the first contact list (col. 3, line 55 – col. 4, line 50).
22. For claims 26, 40, Malone teaches that the wireless device is registered on the web server and associated with a user (col. 5, lines 10 – 50).
23. For claims 27, 41, Malone teaches synchronizing a second contact list stored on the wireless device with the first contact list with a single click of a button on a web browser (col. 5, line 10 – col. 6, line 65; col. 9, lines 20 – 55).
24. For claims 28, 43, Malone teaches storing profile information on the web server, including the first contact list, a user name, a vcard type associated with the wireless device, a phone number associated with the wireless device and an e-mail address (col. 5, lines 10 – 30).
25. For claim 30, Malone teaches sending the one or more contacts to a plurality of SMS-enabled devices (col. 11, lines 1 – 5).
26. For claim 31, Malone teaches a method further comprising:
  - a. saving the contacts on a database if the wireless device is not registered with the web server (col. 5, lines 10 - 30);
  - b. sending the contacts from the database to the wireless device once the wireless device is registered with the web server (col. 8, lines 5 – 25); and
  - c. adding the contacts to a second contact list on the web server associated with the wireless device once the wireless device is registered with the web server (col. 3, lines 40 - 55).
27. For claim 32, Malone teaches a method further comprising:

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- a. sending the wireless device an alert that the contacts have been received and will not be available unless the wireless device is registered with the web server (col. 9, line 30 – col. 10, line 15); and
  - b. sending the wireless device an invitation to register with the web server if the wireless device is not registered with the web server (col. 9, line 30 – col. 10, line 15).
28. For claim 33, Malone teaches sending an e-mail message to a user indicating the wireless device is not registered with the web server if the wireless device is not registered with the web server (col. 9, line 30 – col. 10, line 15).
29. For claim 35, Malone teaches sending multiple business contacts relating to a common category (col. 4, lines 15 – 25), wherein the common category includes restaurants, plumbers, and movie theaters (col. 5, lines 10 – 67).
30. For claim 37, Malone teaches resending one or more unsent contacts of the one or more contacts that are not received by the wireless device (col. 9, line 30 – col. 10, line 15).
31. For claim 38, Malone teaches a method (abstract; col. 1, line 1 - col. 3, line 40; col. 11, lines 20 - 25), comprising:
- a. receiving one or more contacts at a web server (col. 3, lines 55-60) from an SMS-enabled (col. 11, lines 1 – 5) wireless device (col. 5, lines 45 – 55) having a first contact list (col. 6, lines 10 – 25); and
  - b. adding the one or more contacts to a second contact list (col. 5, lines 45 – 55).
32. Malone does not expressly disclose lists stored on a web server. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25) over wireless networks (col. 5, line

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25 – col. 6, line 40). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).

33. For claim 44, Malone teaches matching a phone number of the wireless device with the profile information (col. 5, lines 10 – 30).

34. For claim 45, Malone teaches a method (abstract; col. 1, line 1 - col. 3, line 40; col. 11, lines 20 - 25), comprising:

- a. providing for one or more contacts to be selected via a web browser from a first contact list (col. 6, lines 10 – 50));
- b. adding the contacts to a second contact list (col. 5, lines 45 – 55); and
- c. sending the contacts (col. 8, lines 5 – 25) to an SMS-enabled (col. 11, lines 1 – 5) wireless device (col. 5, lines 45 – 55).

35. Malone does not expressly disclose lists stored on a web server. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 – col. 4, line 67; col. 20, line 50 – col. 21, line 25) over wireless networks (col. 5, line 25 – col. 6, line 40). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 – col. 3, line 30).

36. For claim 46, Malone teaches a method (abstract; col. 1, line 1 - col. 3, line 40; col. 11, lines 20 - 25), comprising:

- a. receiving a contact (col. 3, lines 55 – 60) from a first wireless device (col. 5, lines 45 – 55);

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- b. storing the contact on a first contact list (col. 5, lines 10 - 30);
- c. storing the contact on a second contact list (col. 5, lines 45 - 55); and
- d. sending the contact (col. 8, lines 5 - 25) to a second SMS-enabled (col. 11, lines 1 - 5) wireless device (col. 5, lines 45 - 55).

36. Malone does not expressly disclose lists stored on a web server. Alexander teaches a method (abstract) comprising sending contact and calendar information to wireless systems (col. 1, line 1 - col. 4, line 67; col. 20, line 50 - col. 21, line 25) over wireless networks (col. 5, line 25 - col. 6, line 40). At the time the invention was made, one of ordinary skill in the art would have added Alexander to Malone in order to improve contact location (col. 2, line 40 - col. 3, line 30).

37. Claims 2, 11, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malone and Alexander as applied to claims 1, 10, 19 above, and further in view of Yach et al. (7,295,836).

38. For claims 2, 11, Malone and Alexander do not expressly disclose sending an error message to a user that sent the e-mail message, if the wireless device is not registered with the server. Yach teaches a method and system (abstract) of mobile data communications (col. 1, line 1 - col. 4, line 65; col. 27, lines 10 - 40) that includes this error message (col. 17, line 5 - col. 21, line 5). At the time the invention was made, one of ordinary skill in the art would have added Yach in order to better handle voice and data actions (col. 1, lines 35 - 45).

39. For claim 22, Yach teaches sending an error message to the wireless device if the wireless device is not registered with the server (col. 17, line 5 - col. 21, line 5).

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40. Claims 9, 18, 29, 34, 36, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malone and Alexander as applied to claims 1, 6, 10, 15, 24, 28, 38 above, and further in view of Larikka et al. (2003/0045311).

41. For claims 9, 18, Malone and Alexander does not expressly disclose that the delivery data is extracted from a v-card tag within the e-mail message. Larikka teaches a method (abstract) of providing message information (Paras. 1-32 and 56-57) including the v-card extraction (Para. 42). At the time the invention was made, one of ordinary skill in the art would have added Larikka to Malone and Alexander in order to better handle SMS messages (Paras. 12-14).

42. For claims 29, 42, Malone and Alexander do not expressly disclose sending the one or more contacts comprises sending one or more vcards associated with each of the one or more contacts from the web server to the wireless device. Larikka teaches this limitation (Para. 42).

43. For claim 34, Malone and Alexander do not expressly disclose a method further comprising: determining if a receive buffer in the wireless device has sufficient space to store the contacts; sending some of the contacts to fill the receive buffer; alerting the wireless device that the receive buffer is full; and sending any remaining contacts of the contacts once the receive buffer has space. Larikka teaches this limitation (Para. 44).

44. For claim 36, Malone and Alexander do not expressly disclose determining a type of vcard sent by the wireless device, and formatting the contacts to match the type of vcard used by the wireless device. Larikka teaches this limitation (Para. 42).

### ***Conclusion***

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45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melvin H Pollack/  
Examiner, Art Unit 2445  
11 September 2009